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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912.711	07/25/2001	Takashi Shigetomi	8694.49USC1	8038
23552	7590	12/07/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			PEYTON, TAMMARA R	
			ART UNIT	PAPER NUMBER
			2182	

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,711

Applicant(s)

SHIGETOMI ET AL.

Examiner

Tammara R Peyton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28, 29, 32-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28, 29 and 32-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 28, 29, and 32-40, are rejected under 35 U.S.C. 103(a) as being unpatentable over Feamster et al., patent no. 5,235,586 and Chan et al., patent no. 5,951,687.

As per claims 28, 29, 32, 34, 37, and 40, Feamster teaches disk storage media (removable optical disk cartridge, 10, Fig. 101, Fig.2), comprising an information storage portion (col. lines 29, 32) for storing information and an electronic circuit portion (115, Fig. col. 5, lines 24-29) for processing the information and wherein the information storage portion storing a plurality of information to be used in an external system (102, col. 5 lines 36-47, col. 4, lines 10-11). However,

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Feamster does not teach of said electronic circuit portion including discrimination and selecting means or said plurality of information includes a plurality of emulators of system operating programs.

Chan teaches a discriminating/selecting means (via an electronic circuit portion disk controller, 14, Fig. 1) incorporated in an internal storage device (10, Fig. 1). Chan teaches wherein the storage device (10) is stored with a plurality of operation system drivers that allows the storage medium to emulate multiple types of system operating programs. Depending on the particular operation system driver selected by a selecting means, the disk controller determines if the chosen operating system driver can be matched with the information stored on the information storage portion, if so then the appropriate operating system driver is identified and is uploaded from the storage medium to computer 12. (Chan, Abstract, col. 3, lines 14-17, 25-67, and col. 6, lines 61-col. 7, lines 1-9)

One of ordinary skill would readily recognize that with little programming effort, Feamster's storage chip could be implemented with the same functions and operating system drivers

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as Chan's disk controller. Chan's disk controller prompts for the selection of the appropriate operating system driver and uploads from the storage disk the corresponding operating system program code. This selection screen could be displayed on Feamster's display 124. (Feamster, col. 5, lines 40-44)

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to implement the limitations of Chan into the integrated chip and storage portion of Feamster's optical disk because doing so would eliminate the need for multiple diskettes each having one type of operating system driver configuration by storing multiple types of operating systems drivers configurations on a single optical disk (Chan's storage medium) thereby simplify the interaction between hardware and software models of system processes. (See Chan, Abstract, col. 7, lines 19-38)

As per claims 33, 36, and 39, Feamster nor Chan teach wherein the external system is a computer system having a printer and the information stored in the information storage portion is a parameter for adjusting a printer condition. However, a computer system having a printer is well known in the

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art. Furthermore, a disk having an information storage portion including parameters for a printer is also well known in the art. Feamster-Chan teach selecting information matched for an operation condition of the external system; therefore; one of ordinary skill would readily recognize that the plurality of information stored on the information storage portion could include information for other operating conditions(i.e. printer operating drivers).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (571) 272-4157. The examiner can normally be reached between 6:30 - 4:00 from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin, can be reached on (571) 272-4146 . The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718. Any inquiry of a general nature of relating to

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the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Mailed responses to this action should be sent to:

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Washington, D.C. 20231.

Faxes for Official/formal (After Final) communications or for informal or draft communications (please label "PROPOSED" or "DRAFT") sent to:

(703) 872-9306

Hand-delivered responses should be brought to:

USTPO, 2011 South Clark Place, Customer Window
Crystal Plaza Two, Lobby Room 1B03, Arlington, VA,

22202 Crystal Park II, 2121.

A handwritten signature in black ink, appearing to read 'Tammara Peyton', is written over the printed name.

Tammara Peyton

December 2, 2004